UNITED STATE[illegible] OF COMMERCE
Patent and Trad[illegible]
Address COMMISS[illegible] OF PATENTS AND TRADEMARKS
Washington, D C 20231

09/315,292

17

Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☑ THE PERIOD FOR RESPONSE:

a) ☑ is extended to run 4 Months ~~or continues to run~~ _____ from the date of the final rejection

b) ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1 136(a), the proposed response and the appropriate fee. The date on which the response, the petition , and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee Any extension fee pursuant to 37 CFR 1 17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☐ Appellant's Brief is due in accordance with 37 CFR 1 192(a)

☑ Applicant's response to the final rejection, filed 1/19/01 has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1. ☑ The proposed amendments to the claim and /or specification will not be entered and the final rejection stands because:

a ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.

b ☑ They raise new issues that would require further consideration and/or search. (See Note).

c ☐ They raise the issue of new matter. (See Note).

d ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

e ☐ They present additional claims without cancelling a corresponding number of finally rejected claims
Proposed amendments after final rejection removing the limitations

NOTE "wherein said antisense oligonucleotide is not directed to an A_1 or A_3 adenosine receptor and is not contained in an expression vector" changes the scope of the claims and so would require further consideration and search.

2 ☐ Newly proposed or amended claims N/A would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.

3 ☑ Upon the filing an appeal, the proposed amendment ☐ will be entered ☑ will not be entered and the status of the claims will be as follows:

Claims allowed: None
Claims objected to None
Claims rejected 37-59, 61, 63 and 64

ANDREW WANG
PRIMARY EXAMINER

However,

☑ Applicant's response has overcome the following rejection(s): 35 U.S.C. §112, ¶1, rejection for new matter

4 ☑ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because 1) re: IDS, the copy of the specification of 08/383,666, furnished by the applicant, is not the same as Serial No. 08/383,666 and lacks amendments and the prosecution record; 2) the

5 ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented

☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner

☐ Other supplied references do not show that pulmonary delivery of antisense oligonucleotides would have been predictable for one of skill in the art. Undue experimentation would have been required because inhibition of gene expression by antisense oligonucleotides delivered by pulmonary administration would require trial and error experimentation, given the unpredictability of the antisense art and the lack of particular guidance and direction in applicant's alleged priority documents/ parents. A copy of the IDS, filed 4/03/00, which has been attached.

PTOL-303 (REV. 5-89)